

REMARKS

This responds to the Office Action mailed on September 8, 2008.

Claims 1, 3-4, 6-8, 17-18, 24-25, 32-33, 38-39, 44 and 46-48, are amended, claims 9, 19, 26, 34, 40 and 49 were canceled in a previous response, and no claims are added; as a result, claims 1-8, 10-18, 20-25, 27-33, 35-39, 41-48 and 50-58 remain pending in this application. Support for the amendments may be found throughout the specification, and in particular on at least page 10, lines 6-8 and at page 15, lines 3-8 of the specification. Applicant respectfully submits that no new matter has been introduced with the amendments.

Double Patenting Rejection

Claims 1-8, 10-18, 20-25, 27-33, 35-39, 41-48, and 50-58 were rejected under a non-statutory double patenting rejection, as being unpatentable over Claims 1-28 of Loose et al. (U.S. Patent No. 6,517,433; hereinafter "Loose"). Applicant does not admit that the claims are obvious in view of U.S. Patent No. 6,517,433. Applicant will, if still necessary, file a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(b)(iv) when all other issues related to the patentability of the claims are resolved.

§102 Rejection of the Claims

Claims 1-8, 10-13, 17-18, 20-25, 27-33, 35-39, 41-48, and 50-58 were rejected under 35 U.S.C. § 102(e) for anticipation by Loose. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P. § 2131*. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of

each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully submits that claims 1-2 as amended contain elements not found in Loose.

For example, claim 1 as amended recites the display of a supplemental graphical element, where “the supplemental graphical element comprising pre-recorded video information including full motion video of a person, place or thing.” Claims 4, 7, 17, 24, 32, 38, 44 and 47 as amended recite similar language related to supplemental graphical elements or sets of video images that overlay graphical elements of a wagering game. Applicant has reviewed Loose and can find no disclosure of the use of pre-recorded video information for use as a supplemental graphical element. Loose discloses an animation that “morphs” a blank symbol into another symbol (see e.g., column 4, line 58 to column 5, line 2). However, Loose does not disclose at any point that pre-recorded video of a person place or thing may be used as a supplemental graphical element that is superimposed over another graphical element of a wagering game. As a result, Loose does not disclose each and every element of claims 1, 4, 7, 17, 24, 32, 38, 44 and 47. Therefore Loose does not anticipate these claims. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 4, 7, 17, 24, 32, 38, 44 and 47.

Each of claims 2-3, 5-6, 8, 10-13, 18, 20-23, 5, 27-31, 33, 35-37, 39, 41-43, 45-46, 58 and 50-58 depends from one of claims 1, 4, 7, 17, 24, 32, 38, 44 and 47, and therefore includes through inheritance elements directed to displaying a supplemental graphical element or set of video images comprising pre-recorded video information including full motion video of a person, place or thing. Applicant respectfully submits that dependent claims 2-3, 5-6, 8, 10-13, 18, 20-23, 5, 27-31, 33, 35-37, 39, 41-43, 45-46, 58 and 50-58 are not anticipated by Loose for at least the reasons discussed above regarding independent claims 1, 4, 7, 17, 24, 32, 38, 44 and 47. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 2-3, 5-6, 8, 10-13, 18, 20-23, 5, 27-31, 33, 35-37, 39, 41-43, 45-46, 58 and 50-58.

Additionally, claims 3, 6, 8, 18, 25, 33, 39, 46 and 48 as amended recite that the size of the supplemental graphical element may be dynamically changed. Applicant has reviewed

Loose and can find no disclosure of dynamically altering the size of video images. As a result, Loose does not anticipate claims 3, 6, 8, 18, 25, 33, 39, 46 or 48.

Also, claim 56 recites that "the boundary changes from a first image of the set of video images to a second image of the set of video images, the boundary changing in accordance with changes in the component." In other words, the boundary is dynamically changed in accordance with a change in the shape of a component of the video. The Office Action states that Loose, in Figures 6 and 7 discloses the recited language. Applicant respectfully disagrees with this interpretation of Loose. Nothing in Loose discloses that the boundaries of an image are dynamically altered. Therefore Loose does not teach each and every element of claim 56, and thus does not anticipate claim 56.

§103 Rejection of the Claims

Claims 14-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Loose in view of Poole (U.S. Patent No. 6,375,570). The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in *Graham* are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the

relevant teaching of the references. *Id.* To facilitate review, this analysis should be made explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

Claims 14-16 each depend from claim 7, and therefore inherit the elements of claim 7, including elements directed to overlaying game element images with a set of video images comprising pre-recorded video information including full motion video of a person, place or thing. As discussed above with respect to claim 7, Loose does not teach or suggest the use of pre-recorded video information including full motion video of a person, place or thing as an overlay image. Additionally, Applicant has reviewed Poole and can find no teaching or suggestion of using pre-recorded video information including full motion video of a person, place or thing as an overlay for a graphical element of a wagering game. As a result, neither Loose nor Poole, alone or in combination, teach or suggest each and every element of claims 14-16, including elements inherited from their base claim 7. Therefore there are differences between claims 14-16 and the combination of Loose and Poole. As a result, claims 14-16 are not obvious in view of the combination. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 14-16.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By 

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 9, 2009.

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Signature 